No. 84-1089 (3)

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IN THE

Supreme Court of the United States

October Term, 1984

NICK N. NOVICKY,

Petitioner,

v.

SYNTEX OPHTHALMICS, INC. and ARAPAHOE CHEMICALS, INC. (now SYNTEX CHEMICALS, INC.),

Respondents.

NICK N. NOVICKY,

Petitioner,

v.

GEORGE F. TSUETAKI and FUSED KONTACTS OF CHICAGO, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF RESPONDENTS IN OPPOSITION

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Counterstatement of Questions Presented for Review

1. Whether the granting of title to patents by summary judgment was a denial of due process where supported by written assignments, repeated admissions of petitioner, and portions of a state court judgment affirmed on appeal?

2. Whether there is any conflict between state and federal courts where (a) the state and federal court decisions agree on all findings relevant to the Petition for a Writ of Certiorari, (b) any overlapping issue in the state court was removed to the federal court, and (c) the remaining undecided patent title issue in federal court will soon be decided?

3. Whether petitioner can base any claim of denial of due process on "facts" contrary to express findings in the courts below?

4. Whether this Court should consider petitioner's claim of denial of due process where it was neither pleaded, argued nor briefed in the District Court or the Federal Circuit?

Parties to the Proceeding

The parties named in the caption are the only parties to this action. Respondents' statement pursuant to Rule 28.1 is set forth in the margin.*

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* Syntex Ophthalmics, Inc. and Arapahoe Chemicals, Inc. (now Syntex Chemicals, Inc.) are Delaware corporations. They are sister corporations, each being a wholly owned subsidiary, directly or indirectly, of Syntex (U.S.A.) Inc. which is a Delaware corporation with its principal place of business in California. Syntex Ophthalmics, Inc. has its principal place of business in Arizona. Syntex Chemicals, Inc. has its principal place of business in Colorado.

Petitioner Nick N. Novicky, an individual, is affiliated with Innovative Chemical Research in Whitby, Ontario, Canada, and has a laboratory in Calgary, Canada at 4315 64th Avenue.

George F. Tsuetaki is a resident of the state of Illinois with a business address at Five North Wabash Avenue, Chicago, Illinois.

Fused Kontacts of Chicago, Inc. is an Illinois corporation wholly owned by George Tsuetaki with its principal place of business in Chicago, Illinois.

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BRIEF OF RESPONDENTS IN OPPOSITION

Respondents, Syntex Ophthalmics, Inc. and Arapahoe Chemicals, Inc. (now Syntex Chemicals, Inc.) (hereinafter collectively "Syntex") respectfully request that the Court deny Nick N. Novicky's (hereinafter "Novicky") Petition

for a Writ of Certiorari. Neither the questions presented nor the reasons given by petitioner for grant of the writ provide appropriate bases for the exercise of this Court's discretionary jurisdiction.

I. OPINIONS BELOW

A. The Federal Case

The decision of the District Court for the Northern District of Illinois granting Syntex a preliminary injunction is reported as *Syntex Ophthalmics, Inc.* v. *Novicky,* 214 U.S.P.Q. 272 (N.D. Ill. 1982), *aff'd sub nom., Syntex Ophthalmics, Inc.* v. *Tsuetaki,* 701 F.2d 677, 219 U.S.P.Q. 962 (7th Cir. 1983). The opinion of the District Court for the Northern District of Illinois holding Novicky misappropriated Syntex' trade secrets and granting a final injunction is reported as *Syntex Ophthalmics, Inc.* v. *Novicky,* 221 U.S.P.Q. 860 (N.D. Ill. 1983), *aff'd in part, rev'd in part,* 223 U.S.P.Q. 695 (Fed. Cir. 1984). The opinion of the Court of Appeals for the Federal Circuit affirming the District Court's findings of trade secret theft and grant of summary judgment as to Syntex' title to six of eight patents and applications in issue is reported at 223 U.S.P.Q. 695 (Fed. Cir. 1984).

B. The State Case

The decision of the Illinois state court is reported as *Tsuetaki* v. *Novicky,* No. 80 CH 4724 (Cir. Ct. Cook Cty. Ill. Jan. 31, 1981). The Illinois appellate court decision is reported as *Tsuetaki* v. *Novicky,* Nos. 81-1727/81-2857 (3d Div. 1983).

II. JURISDICTIONAL STATEMENT

This Court only has jurisdiction to review the decision of the Court of Appeals for the Federal Circuit in this matter pursuant to 28 U.S.C. § 1254(1), if a writ of certiorari is granted upon Novicky's petition. The judgment of the Federal Circuit for which this Court's review is sought, was entered October 3, 1984.

III. COUNTERSTATEMENT OF THE CASE

To date, five different courts have summarized the relevant facts: the Illinois state trial court, the Illinois state appellate court, the District Court for the Northern District of Illinois twice, the Court of Appeals for the Seventh Circuit, and the Court of Appeals for the Federal Circuit. The well reasoned and thorough opinions of District Court Judge Decker and Federal Circuit Judge Davis state the relevant facts most accurately and succinctly, and do not need repetition here.

Petitioner's brief, in contrast, is replete with alleged facts which are contrary to facts of public record or directly contradicted by the findings of the courts below. To illustrate:

1. Novicky alleges that Syntex has spent millions of dollars in fighting him because Syntex' patent position is fragile (Novicky Petition p. 5 hereinafter "NP p. 5"). In fact, Syntex is suing on its Gaylord patents (Reissue Patent No. 31,406 and U.S. Patent No. 4,120,570) both in Phoenix, Arizona (C.A. No. 84-260-PHX-WPC) and in Denver, Colorado (Civ. 84-F-1439).

2. Novicky asserts that the Arapahoe batch sheets were discarded by Syntex before this litigation began (NP p. 5). In fact, the Federal Circuit agreed with the District Court's finding that Syntex "made great efforts" to preserve the confidentiality of its trade secrets and that Syntex has trade secrets in the compilation of reactions set forth in the batch sheets. *See, Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695, 703 (Fed. Cir. 1984) (38a-40a)[1].

3. Novicky asserts that on May 12, 1978, he was forced to resign from Syntex because Syntex did not feel that Novicky was qualified to do basic research (NP p. 6). In fact, Syntex promoted Novicky to chemist in 1977 and assigned him to the POLYCON[2] project and "on May 12, 1978, Novicky resigned from Arapahoe and took Arapahoe log sheets and other Syntex documents with him." *Syntex Ophthalmics, Inc.* v. *Novicky,* 221 U.S.P.Q. 860, 863-64 (N.D. Ill. 1983).

4. Novicky asserts that the Illinois appellate court reversed the state trial court decision in its entirety (NP p. 13), yet he fails to mention that the only patent dispute between Novicky and Tsuetaki in the state court litigation concerned title to the two private patents, namely U.S. Patent Nos. 4,242,483 and 4,248,989. The Illinois appellate court accepted the trial court's finding that Novicky conceded the other patents and patent applications at issue were assigned to Tsuetaki in accordance with the employment agreement signed by Novicky. (56a-58a).

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1. Appendix references are to the numbered pages of the Appendix to Novicky's Petition.

2. POLYCON is the registered trademark of Syntex for its rigid, silicon-containing, gas permeable contact lenses.

Specifically, the appellate court noted that (1) Novicky was paid a total of $20,000 for patent application Serial Number 6725 (U.S. Patent No. 4,216,303), (2) Novicky filed two more applications for other inventions which "Novicky agrees belong to Tsuetaki", and (3) Novicky filed three additional patent applications, only two of which [the '483 and '989 private patents] Novicky claimed belong to him. (56a-58a). The Federal Circuit agreed with these state court holdings. *See, Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701 (29a-30a). Thus, the decisions of the Federal Circuit and the Illinois appellate court are not in "head-to-head conflict" as alleged by Novicky (NP p. 22), but rather are consistent with one another on all patent title matters.

5. Novicky alleges that after he left Syntex he invented new silicon monomers which were eventually patented in the '483 and '989 private patents (NP p. 16), despite the holding of the Federal Circuit, based on Novicky's own admissions, that while employed by Syntex "[i]n December 1977, Novicky prepared, signed, and had two Syntex employees witness a patent disclosure" which formed the basis for the '483 and '989 private patents. *Id.* at 698 (9a).

6. Novicky claims that the District Court entered the injunction barring him from using the S-9 monomer "without ever hearing a word of evidence on the issue of whether Novicky had conceived those monomers while he was a Syntex employee . . . or after he left Syntex' employ" (NP p. 19). In fact, the District Court found that when Novicky resigned from Syntex he took with him Arapahoe batch sheets and other Syntex documents, and within a week he was synthesizing "the precursors to [the] 'S-9' monomer." Based on the testimony of Dr. Merker, Novicky's expert,

and Dr. McGrath, Syntex' expert, the Court concluded that "[t]he evidence is overwhelming that Novicky could not have independently developed the procedure for making a related silicone-PMMA within the time it took him to make the S-9 material" and that "[h]e had insufficient time to research and develop the process independently of his work at Syntex." *Syntex Ophthalmics, Inc., supra,* 221 U.S.P.Q. at 864.

7. In a footnote, Novicky alleged that the District Court, while aware that the state trial court judgment was reversed, unaccountably refused to vacate its grant of partial summary judgment to Syntex, upholding its title to the patents in suit (NP fn. p. 19). Contrary to Novicky's allegation, the Court became aware of the reversal of the state court judgment during the preparation of its opinion on the trade secret issues and specifically held that the Illinois appellate court's ruling had no effect on the trade secret claims addressed at trial because the appellate court decision dealt with patent ownership issues. *Id.* at 861 fn. 3.

8. Novicky claims that the Federal Circuit, "in large measure", reversed the decision of the District Court. (NP p. 20). In fact, the Federal Circuit affirmed the grant of summary judgment on the patent title issue as to six of the eight patents and applications on appeal; affirmed the District Court's holding that Novicky misappropriated Syntex' trade secrets and that an injunction was proper; and affirmed the District Court's denial of Novicky's motion to remand the state action back to state court. *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 696 (3a).

9. Novicky claims that the "practical effect" of the Federal Circuit's decision was to deny Novicky a hearing as to the issue of ownership of the patents here in issue (NP p. 21). As shown above, there is only a dispute as to the two private patents, which the Federal Circuit has remanded for the very evidentiary hearing Novicky claims he is being denied.

In short, Novicky is simply ignoring the record below to repeat again his lame arguments uniformly rejected by the District Court for the Northern District of Illinois, the Seventh Circuit and the Federal Circuit. Such a petition lacks even good faith, let alone a showing of denial of due process.

IV. REASONS FOR DENYING THE WRIT

This case does not meet the accepted standards for discretionary review and is not appropriate for certiorari. As stated by Mr. Chief Justice Taft, certiorari should not be granted "except in cases involving principles the settlement of which is of importance to the public, as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals." *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U.S. 387, 393 (1923).

Here there is no conflict between the Federal Circuit's decision and another federal court of appeals, and none is alleged. No conflict exists between the Federal Circuit's decision and the decision of the Illinois appellate court, notwithstanding Novicky's assertion to the contrary. No

conflict exists between the Federal Circuit's decision and any decision of this Court. Finally, the Federal Circuit's decision does not decide any new and important issues of federal law which should be settled by this Court. Rather, the Federal Circuit decision applies well-settled principles of law. Accordingly, the facts disclosed by this record compel the conclusion that the standards governing the exercise of this Court's discretionary power of review upon a writ of certiorari are not met.

V. ARGUMENT

A. The State And Federal Courts Agree On The Issues Asserted By Petitioner As In Conflict

Novicky makes many sweeping assertions of "fact" from which he argues there is a deprivation of due process and a conflict between the state and federal courts. Such assertions are contrary to express findings of the Illinois appellate court and the Federal Circuit.

For example, Novicky once again tries to paint himself as an injured innocent, despite four courts holding four different times that he stole and copied Syntex' trade secret Arapahoe batch sheets almost verbatim and sold them to Tsuetaki. *See,* grant of preliminary injunction to Syntex *Syntex Ophthalmics, Inc.* v. *Novicky,* 214 U.S.P.Q. 272 (N.D. Ill. 1982), *aff'd sub nom., Syntex Ophthalmics, Inc.* v. *Tsuetaki,* 701 F.2d 677 (7th Cir. 1983); and holding that Novicky misappropriated Syntex' trade secrets, *Syntex Ophthalmics, Inc.* v. *Novicky,* 221 U.S.P.Q. 860 (N.D. Ill. 1983), *aff'd in part, rev'd in part,* 223 U.S.P.Q. 695 (Fed. Cir. 1984). All federal courts involved agreed that Novicky

should be enjoined in some form from using Syntex' trade secrets.

All courts involved also agreed that title to all but the two so-called "private patents" (U.S. Patents Nos. 4,242,483 and 4,248,989) do not reside in Novicky.[3] As to the two private patents, all the federal courts and the state appellate court agree that Novicky made these inventions while employed by Syntex under a valid employment contract:

1. *District Court for the Northern District of Illinois:* Novicky assigned the patents here in question to Tsuetaki, evidenced by recorded assignments. *See,* Appendix to Brief for Appellee at 249a-259a, *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695 (Fed. Cir. 1984). Tsuetaki's assignment to Syntex vests title. *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695, 699, 702 (Fed. Cir. 1984) (18a-19a; 31a-32a). The two private patents were invented by Novicky while an employee of Syntex, as evidenced by a written, signed, and witnessed patent disclosure. *Id.* at 698 (9a).

2. *Seventh Circuit* (affirming preliminary injunction): Syntex likely to prevail on the merits, *Syntex Ophthalmics, Inc.* v. *Tsuetaki,* 701 F.2d 677, 682 (7th Cir. 1983); the only dispute is the relative rights of Tsuetaki and Syntex to some patents.

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3. Although the state appellate court reversed the state trial court's judgment, it had no effect on Syntex' title to U.S. Patent Nos. 4,216,303; 4,303,772; 4,314,068; 4,365,074 and applications Serial Nos. 81,682 and 103,408. *See, Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695, 701 (Fed. Cir. 1984) (27a-28a).

3. *Federal Circuit:* Syntex has title to the four patents and two patent applications in question here on petition because of the assignment of patents to Syntex, the settlement agreement with Tsuetaki, and the state appellate court decision which did not disturb the state trial court's findings as to the patent title matters other than the two private patents. *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701-02 (27a-28a; 31a-32a). Novicky admitted that he invented the two private patents while employed by Syntex. *Id.* at 698 (9a), 702 (33a-34a). Whether Syntex affirmatively waived its rights to the two private patents was remanded to the District Court for the Northern District of Illinois for an evidentiary hearing in the near future. *Id.* at 702 (34a-35a).

4. *Illinois Appellate Court:* Affirmed that Novicky's assignment of the four patents and two patent applications here in question to Tsuetaki was valid and binding. (56a-58a); *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701-02 (27a-28a; 31a-32a). The court also recognized that Syntex claimed a property interest in the two private patents, and held that Syntex must be joined as a necessary party to determine Syntex' and Tsuetaki's rights to the private patents. (76a); *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701 (28a).

These repeated holdings that Novicky has no rights to the four patents and two patent applications here in question are consistent, binding and are entitled to preclusive effect.

In the face of such findings, Novicky nonetheless makes the bald assertions that:

— The state "Appellate Court reversed the Circuit Court's decision in its entirety." (NP p. 13).

— Novicky made the inventions disclosed in the two private patents "after he left Syntex." (NP p. 16).

— The state appellate court decision about the four patents was but a "casual remark." (NP fn. p. 21).

— "[T]he Federal Circuit and the Illinois Appellate Court are in a head-to-head conflict." (NP p. 22).

As to the two private patents, Tsuetaki no longer has an interest, having assigned his rights to Syntex as part of the settlement. *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 699, 701 (18a-19a; 25a-27a; 31a). The limited patent title waiver dispute between Syntex and Novicky is on remand to the District Court for the Northern District of Illinois, the first court with jurisdiction over both Syntex and Novicky.[4] Since all courts agree that Syntex has *prima facie* rights to these private patents because of Novicky's invention under the terms of his employment contract with Syntex, no potential conflict exists. This is especially so since the state appellate court has not even remanded yet, while the Federal District Court will try the issue in the near future.[5]

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4. Novicky argues that the state court first had all the parties joined in one action. In fact, Syntex' federal action, joining all three parties, was filed before Count V was added in the state court to join Syntex. *Id.* at 698-99 (12a-14a).

5. Tsuetaki filed a petition for rehearing, asking the state appelpate court to vacate its decision and dismiss Novicky's appeal on the theory that the removal of Count V to the federal court divested the appellate court of jurisdiction. This petition for rehearing is still pending.

As a final note to the quality of Novicky's "factual" assertions, his allegation that "[i]n fact, it is because of Syntex' fragile patent position that it has invested millions of dollars in fighting Novicky as a lone inventor" (NP p. 5), verges on the unethical. In fact, Syntex now has two pending patent infringement suits (one in Phoenix, Arizona C.A. No. 84-260-PHX-WPC and the other in Denver, Colorado Civ. 84-F-1439), asserting its own patents, a fact personally known to counsel for petitioner, since he represents one of the defendants and has acknowledged awareness of the other lawsuit.

In short, the only injustice here is Novicky wasting this Court's time and delaying justice for Syntex. As stated by this Court in *Magnum Import Co.* v. *Coty,* 262 U.S. 159, 163 (1923):

> The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing.

B. Summary Judgment Based On Collateral Estoppel Was Proper

Prior to the trial in the Illinois District Court, Syntex moved for summary judgment granting it title to all the patents and applications in issue by combining offensive collateral estoppel from the state court judgment, *Parklane Hosiery, Inc.* v. *Shore,* 439 U.S. 322, 326 n.4 (1979),

with the settlement with Tsuetaki. Contrary to Novicky's innuendo about a "mysterious settlement agreement" (NP p. 18), the District Court waited until the legal assignment of patents from Tsuetaki to Syntex was filed, then entered final judgment the next day.

The state appellate court later reversed the state trial court decision as to the two private patents because it believed that Syntex' rights could be infringed (76a), but upheld the assignments of the other patents to Tsuetaki, based in large part on Novicky's own admissions. (56a-58a).

On these facts, the Federal Circuit's affirmance of summary judgment as to all but the private patents is proper, since (1) it can take judicial notice of patent assignments recorded in the Patent and Trademark Office; and (2) the portions of the state trial court decision which were neither disputed nor found to be incorrect by the Illinois appellate court still have vitality as collateral estoppel, *Phipps* v. *United States,* 515 F.2d 1099, 1100 (Ct. Cl. 1975); or as the law of the case, 1B *Moore's Federal Practice,* ¶ 0.416[2] at 517 (2d ed. 1983); *Central Soya Co.* v. *Geo. A. Hormel & Co.,* 723 F.2d 1573, 1580 (Fed. Cir. 1983); *Perkin-Elmer Corp.* v. *Computervision Corp.,* 732 F.2d 888, 900 (Fed. Cir. 1984); *Paskaly* v. *Seale,* 506 F.2d 1209, 1211 n.4 (9th Cir. 1974).

The Illinois state appellate court decision affirmed that, pursuant to Novicky's employment agreement with Tsuetaki, Novicky assigned his rights in U.S. Patent No. 4,216,-303 (the "S-9" patent) to Tsuetaki, as reflected on the face of the issued patent. (56a-58a). Two divisionals of the

'303 patent (U.S. Patent Nos. 4,314,068 and 4,365,074) also show assignment to Tsuetaki on their face. *See also, Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701-02, n.18 (25a-27a; 31a).

Novicky also executed written assignments for three other patent applications (*See,* Appendix to Brief for Appellee at 249a-258a, *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695 (Fed. Cir. 1984)), all pursuant to the agreement. One of the applications has issued as U.S. Patent No. 4,303,772, showing assignment to Tsuetaki on its face. *Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 701 (25a-26a). One of the remaining assigned applications is pending and the other has been abandoned.

Novicky himself also admitted in his Answer to Tsuetaki's state complaint that these applications "were assigned by Novicky to Tsuetaki, pursuant to the terms of the Agreement." *See,* Appendix to Brief for Appellee at 169a, ¶ 18, *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695 (Fed. Cir. 1984).

The Federal Circuit reviewed this entire record and held:

> However, as we show *infra,* the appellate court did not disturb the trial court's findings that Tsuetaki was the owner of . . . [the patents in issue]. Accordingly, we hold that Novicky is still precluded from raising his claim to any of these four patents and applications, or his claims to the two divisionals of the '303 patent . . . .

Syntex Ophthalmics, Inc., supra, 223 U.S.P.Q. at 701 (27a-28a). For a detailed discussion *see, id.* at pp. 701-02 (25a-35a).

The Federal Circuit also noted that "[t]he only real patent title dispute between Novicky and Tsuetaki in the original state court litigation concerned the two 'private patents'—the '483 and '989 patents." *Id.* at 701 (29a).

Thus the state court's holding that Novicky assigned the patents in question here to Tsuetaki is undisputed and established beyond question, more than satisfying the requirements of collateral estoppel, res judicata, or, as preferred by the Federal Circuit, the doctrine of claim preclusion. *Id.* at 701-02, fn. 17 (30a).

C. Novicky Has Been Accorded, And Abused, Due Process

To date, Novicky has sought in five different courts to avoid the effects of his blatant theft of Syntex' trade secrets, all from the safe haven of Canada, having fled early-on the reach of both state and federal courts.

Novicky's petition only recites once again his self-serving story, which has been repeatedly rejected by the courts. Significantly, Novicky's petition is largely devoid of page citations to the factual findings of the courts' decisions; that is because those findings are contrary to his assertions. Most important here, Novicky is asking this Court to review the factual findings of the Federal Circuit affirming the District Court's grant of patent title by summary judgment because, Novicky argues, these findings are erroneous. The existing case law does not support Novicky's claim that he has a right to have the factual determinations of the Federal Circuit reviewed by this Court. The law is to the contrary. As stated by Mr. Justice Jackson in

Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 336 U.S. 271, 275 (1949):

> A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error. (citations omitted).

No such showing is made by Novicky. *See also Berenyi* v. *District Director, Imm. Nat. Serv.*, 385 U.S. 630, 635-36 (1967).

Instead, Novicky only makes a conclusory argument, without case law or record citation, that due process has somehow been offended by entry of summary judgment granting patent title to Syntex. As shown, *supra*, there is more than ample basis, not challenged by Novicky, to sustain the court's finding of title in Syntex. Therefore, Novicky's argument is reduced to the absurd assertion that summary judgment and the lack of an evidentiary hearing *per se* violate due process.

The relevant law on summary judgment provides that the Federal Circuit could affirm on any ground that appears in the record, provided the parties have had the opportunity to brief the issue. *Paskaly* v. *Seale*, 506 F.2d 1209, 1211, n.4 (9th Cir. 1974); *Helena Rubinstein, Inc.* v. *Bau*, 433 F.2d 1021, 1023 (9th Cir. 1970); *Miller* v. *Gateway Transportation Co.*, 616 F.2d 272, 275 (7th Cir. 1980). Further, the Federal Circuit properly applied the same tests as the District Court, *Goodman* v. *Mead Johnson & Co.*, 534 F.2d 566, 573 (3rd Cir. 1976), *cert. denied*, 429 U.S. 1038 (1977), and properly looked to the entire record (some 17

volumes of appendices), including depositions, admissions, and affidavits, *Bushman Construction Co.* v. *Connor,* 307 F.2d 888, 892-93 (10th Cir. 1962).

Novicky can only assert that an evidentiary hearing is needed by contradicting his own admissions (*See,* n.6 *infra.*) and ignoring the overwhelming evidence of his assignment of all but the private patents to Tsuetaki.

As to the private patents, Novicky is precluded by the overwhelming evidence from denying he invented these while employed by Syntex.[6] The narrow issue remaining on Syntex' claim to title, i.e., whether Syntex waived its rights, will soon have an evidentiary hearing in the Northern District of Illinois.[7] There being no conflicting state hearing, the federal hearing will decide this patent title issue. Surely there is no need for state court involvement in this issue since (1) Tsuetaki has assigned all his patent rights to Syntex; (2) the federal court first had jurisdiction over both Syntex and Novicky; and (3) the portion of the state court action involving Syntex' rights (Count V) was properly removed before any appeal of that count to the Illinois appellate court. *See, Syntex Ophthalmics, Inc., supra,* 223 U.S.P.Q. at 699-700 (20a-22a). These same factors undercut Novicky's arguments for abstention.

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6. Novicky has repeatedly said these patents belonged to Syntex and not Tsuetaki. *See,* Brief for Appellee at 38-39, *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695 (Fed. Cir. 1984)

7. If this issue is decided against Syntex, Novicky's federal counterclaim for damages relating to the private patents will (as it must) also be decided by the federal court.

In fact, Novicky's implied challenge now to the removal by arguing abstention is itself an abuse, since in state court Novicky himself urged:

> . . . that issues common to the federal action be served [sic—severed] for removal to the federal district court to resolve same in the pending action between the parties.

See, Appendix to Brief for Appellee at 281a, *Syntex Ophthalmics, Inc.* v. *Novicky,* 223 U.S.P.Q. 695 (Fed. Cir. 1984).

When the action was removed, Novicky never challenged its propriety. Only after an adverse trial decision in federal court did Novicky move for a remand. Such procedural legerdemain hardly supports Novicky's claim now of lack of due process or his urging that the controversy should be placed back at square one in the state court.

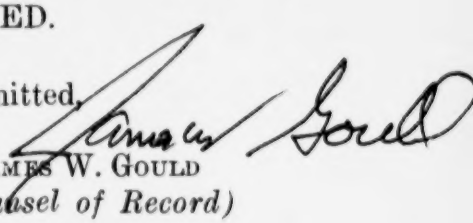
Finally, Novicky did not challenge any of the court's decisions below on due process grounds. Novicky's assertion that he has been deprived of property without due process of law was neither pleaded, argued, nor briefed either in the District Court or in the Federal Circuit, and therefore, this Court should not consider it here. *See e.g., Dunigan* v. *United States,* 274 U.S. 195, 200 (1927); *Ellis* v. *Dixon,* 349 U.S. 458, 460 (1955); *United States* v. *Lovasco,* 431 U.S. 783, 789 n.7 (1977).

VI. CONCLUSION

This legal saga forcefully demonstrates just how far our legal system will go to afford a litigant every opportunity to have his case heard and reviewed, despite repeated, consistent court findings based in large part on Novicky's own admissions. At some point, this litigation must end.

On this record, granting certiorari would itself be an injustice to Syntex and to the Federal Circuit, especially where no conflict exists with other federal or state courts and where the Federal Circuit has applied well established principles of law. Novicky's Petition for Writ of Certiorari should accordingly be DENIED.

Respectfully submitted,



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